

### **REMARKS**

Claims 1 - 25 are pending. By this amendment, claims 1, 13, and 21 are amended, and claim 14 is cancelled. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance are respectfully requested.

### **PERSONAL INTERVIEW**

On August 18, 2005, Applicant's representative conducted a personal interview with Examiners Chai and Revak. The substance of the interview is incorporated in the remarks that follow.

### **CLAIM AMENDMENTS**

Independent claims 1, 13, and 21 are amended as suggested by Examiner Revak to include structural components of the electronic book home system in the claim preamble. These components are shown, for example, in Figure 6b. Claim 14 is cancelled as a consequence of the amendment to the preamble of claim 13.

Entry of the amendments to claims 1, 13, and 21 is proper under 37 C.F.R. § 1.116 because the claim amendments: 1) do not introduce new issues requiring further search or consideration; 2) are in keeping with the formal requirements of the patent statute; and 3) place the application in better form for appeal, if needed. Furthermore, the claim amendments conform to those suggested by Examiner Sheikh, and primarily concern amending the claim preambles of the independent method claims to add structural features.

### **WITHDRAWAL OF THE FINAL REJECTION**

Applicant respectfully suggests that the office action was improperly made final and requests withdrawal of the final rejection under MPEP 706.07(e).

In the February 10, 2005 Amendment, Applicant amended claims 1 and 21. Claim 1 is a method claim. Claim 1 was amended to rearrange its elements and to recite structural details so as to clarify the claimed subject matter, including the location of the method steps. Claim 21 was amended by incorporating the features of dependent claim 26. Accordingly,

Applicant submits that the amendments should not have necessitated new grounds for rejection. Indeed, as discussed in the remarks that follow, the supposed “new grounds for rejection” are completely without merit, and the applied references have nothing to do with the claimed subject matter in claims 1 and 21.

In view of the above remarks, Applicant respectfully requests withdrawal of the finality of the rejection.

## CLAIM REJECTIONS

On page 4, the Office Action rejects claims 1 – 11 and 21 – 25 under 35 U.S.C. § 102(e) over U.S. Patent 5,509,074 to *Choudhury* (hereafter *Choudhury*). This rejection is respectfully traversed.

### Claim 1

Considering claim 1, the Office Action asserts that *Choudhury* teaches all the elements recited therein, specifically “[i]n the library, comparing a unique key associated with data text of an electronic book to a corresponding unique key of the viewer (Choudhury: see for example, Column 4 Line 13 – 18, Column 2 Line 57 – 60 and Column 2 Line 65 – 67: the library is interpreted as the collection of document server and copyright server. The unique key is interpreted as the unique identification presented by the user when making a request for a document ... .”

Accepting, for argument’s sake, the Examiner’s interpretation of claim 1’s elements and *Choudhury*’s disclosure, one can readily see a clear distinction between claim 1 and *Choudhury*. Specifically, in *Choudhury*, the user’s unique identification is used to authenticate a document request. See, e.g., column 1, lines 38 – 43: “receiving requests for documents ... including with the requests unique user identification ... [and] authenticating the requests ... With [sic] a copyright server ... .”; column 4, lines 13 – 20: “When the User 117 wants to view or print a document, he must make a request for a document via network 109 by using a unique identification, such as a credit card number ... . The Copyright Server 107 will authenticate the User’s request and then the Document Server 103 sends out an encrypted copy directly to the display device 121 ... .”

As discussed during the personal interview, what these two passages from *Choudhury* make clear is that the Document Server 103 and the Copyright Server 107, which the

Examiner equates to the claimed library, do not compare a unique key associated with data text of an electronic book to a corresponding unique key of a viewer. Instead, the Copyright Server 107 uses the user's unique identification to authenticate (or authorize) a request for a document. If the user's request is authenticated by the Copyright Server 107, the Copyright Server 107 directs the Document Server 103 to send an encrypted version of the requested document directly to the display device. Thus, the Copyright Server 107 never compares a unique key of the display device 121 with either the user's unique identification or any identification associated with the requested document.

Contrast *Choudhury's* system with that recited in claim 1: as discussed during the personal interview, in claim 1, a unique key "associated with data text" of an electronic book is compared to a corresponding unique key of a viewer, and the comparison is executed "in the library." *Choudhury's* Copyright Server 107 merely authenticates requests.

*Choudhury's* Copyright Server 107 most definitely does not execute a comparison of unique keys between a document and a document display device. Necessarily, because *Choudhury's* Copyright Server 107 does not execute the claimed comparison, *Choudhury* cannot disclose or suggest the second element of claim 1, namely "if the comparing step produces a match, sending the data text related to an electronic book from the library to the viewer." Thus, *Choudhury* does not disclose or suggest all the features of claim 1, and claim 1 is patentable.

#### **Claim 4**

Dependent claim 4 recites, *inter alia*, "decrypting the data text as the data text is displayed." The "on-the-fly" decryption serves as a further security mechanism to prevent theft or inadvertent loss of the electronic book. That is, only the text to be immediately viewed is decrypted, so that even if the entire electronic book file were somehow to be lost or stolen, at most, only one "page" of the electronic book would be in a decrypted format. The remainder of the electronic book file would still be encrypted, thus keeping in place a measure to prevent its unlawful dissemination.

The Office Action cites *Choudhury* at column 3, lines 44 – 45 and column 4, lines 25 – 31 as disclosing the above-recited feature from claim 4. In fact, the cited passages from *Choudhury* disclose nothing of the sort.

Column 3, lines 44 – 45 state: "Display Agent 11 includes software trusted by publisher which decrypts and displays the document obtained from Document Server 3." Clearly, there is nothing in this passage that discloses or suggests "decrypting the data text as

the data text is displayed.” All *Choudhury* discloses is software that both decrypts and displays a document. The software most certainly does not decrypt “data text as the data text is displayed,” as recited in claim 4.

The Office Action then states that “( ... the device (either screen displayer or printer) must use microprogram memory buffer (or memory page) to perform the functions of decrypting and displaying electronic documents and accommodate display buffer / page one [sic] at a time). Apparently, the Examiner is arguing that Choudhury inherently discloses the microprogram memory buffer and that such a memory device performs the functions recited in claim 4. The Examiner is wrong on two counts. First, *Choudhury*’s device could inherently include decryption of the entire document, and subsequent storage in memory prior to display. However, *Choudhury* simply does not disclose how the decryption function is executed. Second, Where a reference is alleged to inherently disclose a claim element, the missing element must necessarily be present in the cited reference and that it be so recognized by those of ordinary skill in the art. It is not enough that the missing element is possibly or probably present. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The Examiner has not shown that the “microprogram memory buffer” is present, and that it performs the claimed decryption of “the data text as the data text is displayed.” Hence, *Choudhury* does not disclose or suggest all the elements of claim 4.

Because *Choudhury* does not disclose or suggest all the elements of claim 4, claim 4 is patentable. Claim 4 is also patentable because of its dependence on patentable claim 1.

#### **Claim 7**

Claim 7 recites, *inter alia*, “decompressing the data text as the data text is displayed.” Similar to the on-the-fly decryption recited in claim 4, this on-the-fly decompression of the data text is a security measure to prevent unlawful access to an electronic book file.

In rejecting claim 7, the Office Action refers to the same passages from *Choudhury* that the Office Action used in rejecting claim 4. The cited passages from *Choudhury* disclose decryption, not decompression. Claim 7 recites “decompressing the data text file.” Thus, the cited passages do not disclose or suggest all the features of claim 7. Furthermore, there is nothing in *Choudhury* that discloses “decompressing the data text as the data text is displayed,” as recited in claim 7, and claim 7 is, therefore, patentable. In addition, claim 7 depends from patentable claim 1, and for this reason, claim 7 is also patentable.

### **Claim 9**

Claim 9 recites, *inter alia*, decompressing and decrypting the data text one page at a time, as a current page is displayed on the viewer.

In rejecting claim 9, the Office Action repeats the rationale applied for rejecting claims 4 and 7. And just as that rationale is inappropriate for rejection claims 4 and 7, so it is inappropriate for rejecting claim 9. Claim 9 discloses features not disclosed or suggested by *Choudhury*, and for this reason, and because of its dependence on patentable claim 1, claim 9 is patentable.

### **Claim 21**

Independent claim 21 recites, *inter alia*, “decompressing and decrypting an electronic book page by page, just before a page is displayed on a display of the viewer.”

In rejecting claim 21, the Office Action asserts that *Choudhury* discloses all that claim 21 recites, including “decompressing and decrypting an electronic book page by page, just before a page is displayed on a display of the viewer.” As noted above with respect to the rejection of claims 4 and 7, *Choudhury* simply does not disclose or suggest page-by-page decryption just before display on a viewer. Rather, *Choudhury* is silent as to the method and timing of the decryption process, and again, the Examiner appears to be using inherency in an impermissible fashion in his rejection.

The Office Action also states “The user is qualified as a viewer.” *Choudhury*’s “user” is a human being. As noted above, claim 21 recites displaying a page of the electronic book “on a display of the viewer.” If we accept the Examiner’s position that a human being qualifies “as a viewer,” how does the human being incorporate the claim element of a “display?” Is the Examiner suggesting that humans have displays? Applicant respectfully requests that the Examiner read the claims carefully and consider each and every element recited therein before rejecting the claims.

### **Claims 2, 5, 6, 10, 11 and 22 – 25**

Claims 2, 5, 6, 10 and 11 depend from patentable claim 1, and claims 22 – 25 depend from patentable claim 21. For these reasons, and the additional features they recite, claims 2, 5, 6, 10, 11, and 22 – 25 are also patentable.

Withdrawal of the rejection of claims 1 – 11 and 21 – 25 under 35 U.S.C. § 102(e) is respectfully requested.

On page 9 the Office Action rejects claims 13, 14, and 17 – 20 under 35 U.S.C. § 102(b) over U.S. Patent 5,089,956 to MacPhail (hereafter MacPhail). This rejection is respectfully traversed.

*MacPhail* is directed to methods of distributing at least two documents stored in an information processing system whereby the documents have a directed relationship. See column 2, lines 51 – 55. Thus, *MacPhail* is directed to a document management system, and does not disclose or suggest anything regarding communications between components of an electronic book home subsystem. Moreover, nothing in *MacPhail* discloses or suggests in a library, comparing a unique key associated with data text of an electronic book with a corresponding unique key of a viewer. *MacPhail*'s process for transferring stapled documents from a storage server to an end user (EU) is described with reference to Figure 7 at column 8, lines 1 – 50. An identifier DID entered by the EU is assigned to a “stapler” document, and this identifier DID is then used to associate (“staple”) other documents that have a directed relationship (“stapled”) to the stapler document. Furthermore, the documents disclosed in *MacPhail* are not electronic books. Clearly, at no time does *MacPhail*'s process compare a unique key associated with a viewer with a unique key associated with data text of an electronic book to permit sending the data text to the viewer.

### **Claim 13**

With respect to claim 13, the Office Action asserts that *MacPhail* discloses at column 1, lines 38 – 42 and column 4, lines 26 – 31, determining whether a packet has a unique packet identifier and determining whether the packet identifier matches a library identifier; and at column 4, lines 26 – 45 and 58 – 66, and column 1, lines 38 – 49, if the packet identifier matches the library identifier, storing the packet to a data file in the library storage. Applicant strongly disagrees. In fact, the above-cited references do not disclose anything remotely close to the elements recited in claim 13. Instead, the above-cited references merely disclose that a storage library stores documents according to a specific structure, referred to in column 4 of *MacPhail* as a Document Interchange Architecture. But nothing in the above-cited references to *MacPhail*, or in any other part of *MacPhail* disclose or suggest receiving a packet of text data, determining if the packet has a unique identifier, comparing the packet identifier to a library identifier, and if the packet and library identifiers match, storing the packet in a data file of the library.

In contrast to *MacPhail*, claim 13 recites receiving a packet of text data, determining if the packet has a unique identifier, comparing the packet identifier to a library identifier, and if the packet and library identifiers match, storing the packet in a data file of the library. Since these features are not disclosed or suggested by *MacPhail*, claim 13 is patentable.

**Claims 14 and 17 - 20**

Claim 14 is cancelled and its rejection is moot. Claims 17 – 20 depend from patentable claim 13. For this reason and the additional features they recite, claims 17 – 20 are also patentable.

Withdrawal of the rejection of claims 17 – 20 under 35 U.S.C. § 102(b) is respectfully requested.

On page 12 the Office Action rejects claim 12 under 35 U.S.C. § 103(a) over *Choudhury* in view of U.S. Patent 4,985,697 to *Boulton* (hereafter *Boulton*). This rejection is respectfully traversed.

Claim 12 depends from patentable claim 1. For this reason and the additional features it recites, claim 12 is also patentable. Withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a) is respectfully traversed.

On page 13 the Office Action rejects claim 15 under 35 U.S.C. § 103(a) over *MacPhail* in view of *Boulton*. This rejection is respectfully traversed.

Claim 15 depends from patentable claim 13. For this reason and the additional features it recites, claim 15 is also patentable. Withdrawal of the rejection of claim 15 under 35 U.S.C. § 103(a) is respectfully requested.

On page 13 the Office Action under 35 U.S.C. § 103(a) over *MacPhail* in view of U.S. Patent 4,644,470 to *Feignbaum* (hereafter *Feignbaum*). This rejection is respectfully traversed.

The Office Action admits that *MacPhail* does not disclose the claimed element “if the packet does not have a unique packet identifier, storing the packet to an electronic message

file,” but then asserts that *Feignbaum* does disclose this feature, citing *Feignbaum* at column 4, line 45.

*Feignbaum* is directed to a naming convention for entities that are coupled together in a local area data communications network. Messages to be multicast to these entities are sent on the basis of the entities’ name. A processor in the system may seek to assign a unique name to an entity. To complete this name assignment, the processor broadcasts a Name Check signal containing the proposed unique name, and other processors in the network compare the proposed unique name to existing entity names. On finding a match, the processor finding the match send an acknowledgment to the processor seeking to adopt the unique name, causing abandonment of the name adoption. However, a processor in *Feignbaum*’s system can a name as non-unique, and when a request for adoption of the same name is received, the receiving processor ignores the name check, thereby allowing adoption of the name by a second entity. See, e.g., column 2, lines 30 – 52. *Feignbaum* most definitely does not disclose the claimed element of “if the packet does not have a unique packet identifier, storing the packet to an electronic message file.” In other words, *Feignbaum*’s naming process is not the same (even remotely the same) as the elements recited in claim 16.

In contrast to *MacPhail* and *Feignbaum*, claim 16 recites “if the packet does not have a unique packet identifier, storing the packet to an electronic message file.” Since *MacPhail* and *Feignbaum*, individually and in combination, do not disclose or suggest this feature, claim 16 is patentable. In addition, claim 16 depends from patentable claim 13, and for this reason claim 16 is patentable. Withdrawal of the rejection of claim 16 under 35 U.S.C. § 103(a) is respectfully requested.

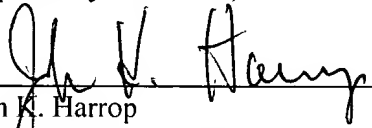
In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.



Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

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Respectfully submitted,

  
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